



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,574	11/17/2003	Mutsuya Kitazawa	30293-64	4721

7590

07/17/2006

Mitchell P. Brook, Esq.
LUCE, FORWARD, HAMILTON & SCRIPPS LLP
Suite 200
11988 El Camino Real
San Diego, CA 92130

EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,574

Applicant(s)

KITAZAWA, MUTSUYA

Examiner

Jyoti Nagpaul

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35, 43-47, 49-52, 54 and 57-59 is/are rejected.
- 7) ☒ Claim(s) 36-42, 48, 53, 55 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Amendment filed on March 10, 2006 has been acknowledged. Claims 33-59 are pending.

Response to Amendment

Rejection of Claims 33-41, 43-45 and 48-52 as being anticipated by Venooker has been withdrawn in light of applicant's amendments and arguments.

Rejection of Claims 53-56 as being unpatentable over Venooker in view of Clark has been withdrawn in light of applicant's amendments and arguments.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 33-35, 44-45, 49-52, 54 and 57-59** are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 4806316).

Johnson teaches a self-pipetting device for use in chemical, immunochemical and microorganism analysis. The device comprises a fluid container (29), the fluid container being attachable in fluid communication with a coupler (27). The coupler (27) comprising a first longitudinally extending cylindrical ring (27) defining an interior area and a longitudinally extending fluid conduit/ the top of the vial (29) positioned within the interior area and defining a fluid flow aperture. (See Figures 3 and 4) The device further comprises a laterally extending wall between the first cylindrical ring (27) and the

Art Unit: 1743

fluid conduit/the top of the vial (29), the laterally extending wall having a top surface directed towards the processing apparatus (11) and defining at least one vent aperture (34) creating fluid venting communication between the fluid reservoir (29) and the top surface. (See Figure 4) The device further comprises at least one vent apertures (34) provide fluid venting communication between the reservoir (29) and the processing apparatus (11). The fluid conduit/ the top of the vial (29) provides bi-directional fluid communication (31,33) between the fluid reservoir (29) and the processing apparatus (11). (See Col. 5, Lines 9-11 and 35-37) The device further comprises the first cylindrical ring (27) is configured to mate with a corresponding connector (26) on the processing apparatus (11) substantially forming a seal creating an enclosure between the interior of the first ring (27) and the processing apparatus (11). (See Figure 4) The fluid conduit/ the top of the vial (29) is configured to mate with a corresponding fluid conduit (17) of the processing apparatus (11). The device further comprises attaching the coupler (27) to the fluid container (29) such that the fluid container is in fluid communication with the at least one vent aperture (34) and attaching the top surface of the coupler (27) to the processor system (11). (See Figures 3 and 4)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1743

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim 43 and 46-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Cox.

Refer above for the teachings of Johnson.

Johnson fails to teach a plurality of vent apertures arranged concentrically within the wall and a concentric vent ring is in communication with the interior of the tissue processor.

Cox teaches a device for assessing a fluid sample. The device comprises a plurality of vent apertures (8) arranged concentrically within the wall and a concentric vent ring is in communication with the interior of tissue processor (6).

It would have been obvious to one of the ordinary skill in this art at the time of the invention by applicant to modify the system of Johnson in order to vent the displaced air from the processor so as to retain a simple and substantially rigid structure for the device as taught by Cox.

Allowable Subject Matter

Claims 36-42, 48, 53 and 55-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art fails to teach a second cylindrical ring longitudinal adjacent the first cylindrical ring. Prior art fails to teach the fluid conduit is disposed within the first and second cylindrical rings and passes through the wall between interior spaces defined by the rings. Prior art fails to teach positioning the fluid container assembly adjacent an appropriate locking assembly.

Response to Arguments

Amendment filed on March 10, 2006 has been acknowledged. Applicant's arguments with respect to claims 33-59 have been considered but are moot in view of the new ground(s) of rejection. Please refer above.

Art Unit: 1743

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN



**YELENA GAKH
PRIMARY EXAMINER**